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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,840	02/17/2005	Hans Lorenz	264826US0PCT	3158
22850	7590	10/31/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WOOD, ELLEN S	
			ART UNIT 4174	PAPER NUMBER
			NOTIFICATION DATE 10/31/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

## Office Action Summary

**Application No.**

10/524,840

**Applicant(s)**

LORENZ ET AL.

**Examiner**

Ellen S. Wood

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/17/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II Claims 13-16 in the reply filed on 10/08/2007 is acknowledged. The traversal is on the ground(s) that the search is expanded to the non-elected claims of Group I, Claims 1-12, if the elected Group II claims are found allowable. This is not found persuasive because the Applicant elected with traverse, however did not inform the examiner of why the restriction is not proper, thus the Examiner will review the case as if the Applicant elected without traverse.

The requirement is still deemed proper and is therefore made FINAL.

2. The Examiner notes that if the elected Group II is found allowable then the Examiner will graciously expand the search to the non-elected claims of Group I, claims 1-12 and 17. The paragraph listed below is how the examination of the restriction will take place.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to

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be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Claim Objections***

4. Claim 15 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Theil et al. (US 5,837,091, hereinafter "Theil").

In regards to claim 13, Theil discloses the thermal adhesion of at least two acrylic plastic parts (col. 1 lines 7-8). Theil discloses that the polymethacrylate plastic parts comprise of polymerizates of methyl methacrylate, which can be comprised of up to 50 wt.-% of other monomers which can be copolymerized with methyl methacrylate. The proportion of methyl methacrylate be 80 to 100 wt.-% (col. 3 lines 32-36). The polymethacrylate plastics with the composition disclosed by Theil can be thermoplastically or thermoelastically formed (col. 3 lines 44-45). Theil discloses that the aver molecular weights MW are between  $3 \times 10^4$  and approximately  $5 \times 10^6$  (col. 3 lines 50-51).

In regards to claim 14, Theil discloses that the invention relates to the thermal adhesion of at least two acrylic plastic parts (col. 1 lines 6-7). Theil discloses that the polymethacrylate plastic parts are sheets, which have engraving or embossings (col. 2 lines 54-56), thus have a microstructured surface. The plastic parts comprise of the composition as disclosed. According to applicant the backing layer is composed of a polymethacrylate moulding composition which comprised from 80 to 100% by weight of free-radical-polymerized methyl methacrylate unites and of from 0 to 20% by weight of other co-monomers capable of free-radical polymerization (pg. 5 lines 31-37). Applicant discloses that the structure layer is composed of the same materials as the backing layer (pg. 7 lines 1-11). Thus, the Examiner interprets the polymethacrylate plastic parts disclosed by Theil would be considered a backing layer and/or a structure layer.

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In regards to claim 15, Theil discloses that flat objects can be embedded between the adhesion sides of the sheets, such as thermoplastic elastomers and narrow strips of plastic (col. 5 lines 23-37). These flat objects are considered a backing layer where the polymethacrylate plastic sheets are the structure layers.

In regards to claim 16, Theil discloses that the polymethacrylate plastic parts are sheets or films (col. 2 lines 42-43). Theil discloses that the polymethacrylate plastic parts are sheets, which have engraving or embossings (col. 2 lines 54-56).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen S. Wood whose telephone number is 571-272-3450. The examiner can normally be reached on Monday-Thursday 7:30am-5:00pm EST Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ellen S Wood  
Examiner  
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A handwritten signature in black ink, appearing to read "DL Tarazano", with a large, stylized flourish at the end.

**D. LAWRENCE TARAZANO**  
**PRIMARY EXAMINER**